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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,974	06/04/2001	Mathew A. Von Wronski	2238-7	6852

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EXAMINER

AUDET, MAURY A

ART UNIT PAPER NUMBER

1654

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/871,974

Applicant(s)

VON WRONSKI ET AL.

Examiner

Maury Audet

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-9,23-39 and 49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-9,23-39 and 49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>See Cont. Sheet</u>   | 6) <input type="checkbox"/> Other: _____                                    |

Continuation Sheet (PTOL-326)

Application No.

IDS Cont. 01/08/2003, 08/06/2002, 04/05/2002.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's response of 01/07/2004 to the Office Action of 10/03/2003, electing Group I, with traverse, is acknowledged. Applicant's arguments have been fully considered but are not persuasive. Furthermore, Applicant has cancelled all the claims, other than claim 49, that were formerly within Groups II and III. Although the Examiner has maintained the restriction as set forth, the Examiner is willing to rejoin claim 49 with the claims of elected Group I, for examination on the merits.

Additionally, Applicant was telephoned in order to specifically elect the specific composition as the invention (not species) drawn to elected invention of Group I. During a telephone conversation with Scott McNees on 3/2/2004 a provisional election was made with traverse to prosecute the invention of Formula I (A-L-B), wherein A is a monomer and specifically TKPPR; L is any linker; and B is the substrate phospholipids. Affirmation of this election must be made by applicant in replying to this Office action. It is noted at the outset, that all pending claims, namely claims 1, 4-9, 23-39, and 49, have only been examined on the merits as being drawn to the elected composition.

### ***Response to Amendment/Arguments***

Applicant's response of 12/31/2003 to the Office Action of 07/25/2003 is acknowledged.

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-9, 23-39, and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Pollak (US 9,638,185).

The elected invention, as drawn to pending claims 1, 4-9, 23-39, and 49, is a composition of Formula I: A-L-B, namely, Monomer TKPPR-Any Linker-Substrate Phospholipids and a method of using said composition.

Pollak teaches monomer TKPPR (col. 3, lines 61-65; SEQ ID NO: 1) conjugated to a linker (e.g., col. 4, lines 51-67 to col. 5, lines 1-10) and any substrate that is “insoluble and inert in labeling solutions and can be functionalized with a linking group” (which “phospholipids” are categorizable in)(e.g., col. 4, lines 34-50). Additionally, Pollak also teaches a method of using this composition for diagnostic/radiodiagnostic imaging (e.g., col. 1, lines 12-32; col. 5, line 56)(see entire specification).

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-9, 23-39, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pollak (US 5,789,555).

Pollak is discussed above. Pollak, although teaching that *any* substrate that is “insoluble and inert in labeling solutions and can be functionalized with a linking group” may be used in the composition (which would encompass the characteristics of elected “phospholipids”), does not expressly teach the use of “phospholipids” as the substrate in the composition.

If not inherently taught therein, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made, to use “phospholipids” as the substrate of Pollak, because it is well within the purview of one of skill in the art to use *any* substrate that is “insoluble and inert in labeling solutions and can be functionalized with a linking group”, in view of Pollak, and one of skill in the art would recognize that phospholipids are one of the compounds that fall within this non-limiting group of substrates (as Applicant has so claimed, i.e. Claim 5).

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Claims 1, 4-9, 23-39, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pollak (US 5,789,555) in view of Barbera-Guillem (US 6,252,664).

Pollak is discussed above. Pollak, although teaching that *any* substrate that is “insoluble and inert in labeling solutions and can be functionalized with a linking group” may be used in the composition (which would encompass the characteristics of elected

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“phospholipids”), does not expressly teach the use of “phospholipids” as the substrate in the composition.

Barbera-Guillem teaches the use of phospholipids as substrates (col. 5, lines 6-7 and 19) in imaging compositions (abstract).

If not inherently taught therein, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use “phospholipids” as the substrate of Pollak, because Barbera-Guillem teaches the advantageous use of phospholipids as substrates in imaging compositions; and because Pollak that *any* substrate that is “insoluble and inert in labeling solutions and can be functionalized with a linking group” may be used in the composition (which would encompass the characteristics of elected “phospholipids”)

### *Conclusion*

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maury Audet whose telephone number is 571-272-0960. The examiner can normally be reached from 7:00 AM – 5:30 PM, off Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Brenda Brumback can be reached at 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

MA, 3/20/04

  
CHRISTOPHER R. TATE  
PRIMARY EXAMINER